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REMARKS

By the present amendment, new claim 28 has been added.

Support for new claim 28 is found in the original application, in particular claims 1, 2 and 6.

Claims 1-11, 12-20 and 22-28 are pending in the present application. Claims 1-10, 13-20, 22-25 and 27-28 are directed to a plane light source and claims 11 and 26 are directed to a liquid-crystal display device.

As a preliminary, Applicants and Applicants' representative thank the Examiner and his Supervisor for the Personal Interview which was held on May 7, 2003.

New claim 28 corresponds to claim 6 rewritten in independent form by incorporating therein the subject matter of claims 1 and 2. It is submitted that new claim 28 is immediately allowable, as acknowledged in the Interview Summary.

Next, Applicants again traverse the rejections of claims 1-4, 9-12, 14-16 and 22-26 under 35 U.S.C. 103(a) as obvious over US 5835661 (Tai), and of claims 5-8 and 17-20 under 35 U.S.C. 103(a) as obvious over Tai in view of US 5727107 (Umemoto), as set forth in the Office Action dated September 27, 2002.

In particular, Applicants traverse the assertion made in the Interview Summary that present claim 1 reads on Tai ("it reads the present invention as claimed in claim 1-11"). Applicants submit that Tai clearly does not have, and does not even suggest, a linear light pipe having a refractive index higher than that of said plane light pipe, as recited in present claim 1.

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Reference is made to the decision Schering Corp. v. Geneva Pharmaceuticals Inc. (D. N.J. 2002) reported at 64 USPQ2d (BNA) 1032, which was mentioned by Examiner's Supervisor has supporting the assertion that the disclosure in Tai was sufficient to inherently anticipate the recitation "having a refractive index higher than that of said plane light pipe" in present claim 1.

It is submitted that the Schering decision does not stand for such a proposition, but rather, supports a finding of no inherent anticipation in the present case. The invention at issue in Schering, a chemical compound, was held inherently anticipated by a metabolic process of production of the compound in the body, which was unknown at the time of the invention, but which was discovered and documented later. Thus, Schering dealt with an unknown but necessarily occurring natural phenomenon. See Schering at 1038 ("In the present matter, there is no genuine issue that the consumption of loratadine by humans, with a variety of health statuses, necessarily results in the natural production in the human body of the DCL metabolite") (emphasis added).

Indeed, Schering reaffirms the conventional test on inherency established by the Federal Circuit in Continental Can Co. USA v. Monsanto Co., 20 USPQ2d 1746 (Fed. Cir. 1991); "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." See Schering at 1039. See also the Manual of Patent Examining Procedure (MPEP): "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," MPEP §2112, and the decisions cited therein.

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In the present case, in contrast to the fact situation in Schering, there is no difference in refractive indices between the linear and planar light pipes that would "necessarily result" from the structure disclosed in Tai. Therefore, the inherency test of Continental Can, as applied to the present facts in the same way as the Schering court, clearly leads to a finding that Tai does not inherently anticipate a linear light pipe having a higher refractive index than the planar light pipe, as recited in present claim 1.

Specifically, Tai discloses the following:

- "The microprisms 72 can be constructed of any suitable transparent material such as glass, acrylic or polycarbonate having the same or approximately the same index of refraction as the second beam expanding light pipe 70" (Tai at col. 13, lines 38-41)
- "The adhesive 71 is made of a material that has a lower index of refraction than the first and second beam expanding light pipes 14' and 70'" (Tai at col. 14, lines 9-12)
- "In one embodiment, the adhesive 71 is made of an acrylic-based material having an index of refraction of 1.455 and the first and second beam expanding light pipes 14' and 70' are made of a material having an index of refraction of 1.49" (Tai col. 14, lines 16-20)

The first statement refers to the refractive index of microprisms 72 on the surface of the planar light pipe 70 (see Fig. 6 of Tai). The second statement refers to the refractive index of an adhesive 71 between the linear light pipe 14' and the planar light pipe 70' (see Fig. 7 of Tai). The third statement explicitly teaches that the refractive index of the linear light pipe 14' is the same as the refractive index of the planar light pipe 70. Thus, the disclosure of Tai does not "necessarily result" in a linear light pipe having a higher refractive index than the planar light pipe. On the

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contrary, there is absolutely no suggestion or motivation in Tai to provide linear and planar light pipes having different refractive indices.

Even if, arguendo, a person of the art had been motivated to use "the same or approximately the same index of refraction" for the linear and planar light pipes (although this features is taught in Tai for the microprisms 72 on the surface of the second beam expanding light pipe 70, not for the linear and planar light pipes), this would not "necessarily result" in the linear light pipe having a higher refractive index than the planar light pipe, as required for inherency, in the absence of any other indication in Tai as to how to obtain "approximately the same" refractive indices. Therefore, the present claims are not anticipated by Tai, and not obvious from Tai taken alone or in any combination with Umemoto, which fails to remedy the deficiencies of Tai.

In view of the above, it is submitted that the rejections should be withdrawn.

In the event there is, in the Examiner's opinion, any outstanding issue, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

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In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 01-2340.

Respectfully submitted,

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